

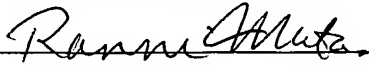
PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
10547.26US2

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on August 21, 2006

Signature



Typed or printed

name Ranni Matar

Application Number

10/614,584

Filed

07/07/2003

First Named Inventor

Krausz et al.

Art Unit

2178

Examiner

Huynh, Cong Lac T

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

X

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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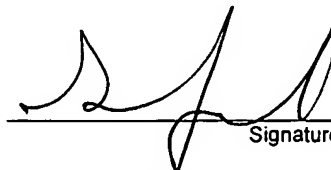
- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

- ☒ attorney or agent of record.

Registration number 35,906

- ☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Gary R. Jarosik

Typed or printed name

(312) 456-8449

Telephone number

August 21, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



REASONS FOR REVIEW REQUEST

In the application claims 14-22 remain pending and presently stand rejected under 35 U.S.C. § 103 as allegedly being rendered obvious by Viswanath (U.S. Published Patent Application No. 2003/0074271) as modified by Matsakis (U.S. Published Patent Application No. 2005/0273772) as further modified by Peat ("Introducing XML/EDI...the e-business framework").

In response to this rejection of the claims, it is respectfully submitted that, to maintain a rejection under 35 U.S.C. § 103, the references being relied upon must disclose all of the claimed elements considering each and every word thereof, i.e., the claim must be considered "as a whole." Since none of Viswanath, Matsakis, nor Peat, discloses, teaches, or suggests at least the claimed element of providing a graphical user interface tool to create a file (whether IML or otherwise) that includes a first set of tags (whether IML or otherwise) defined by a document type definition that are used to select data for inclusion in a document (whether an invoice or otherwise) and a second set of tags (whether IML or otherwise) defined by the document type definition that are used to specify *both a page style for the document and how to display the selected data within the document* it is respectfully submitted that the rejection of the claims must be withdrawn.

While the rejection of the claims has asserted that Viswanath discloses a graphical user interface tool for creating a file including XML tags for selecting data for inclusion in a purchase order and for specifying a layout for the purchase order including the selected data, it is respectfully submitted that Viswanath does not disclose using a graphical user interface tool for this purpose. Instead, Viswanath only discloses the use of a graphical user interface tool for the purpose of allowing an existing electronic catalog to be mapped to the e-procurement system disclosed within Viswanath:

Catalog management module 200 allows suppliers to map their

existing catalogs to the e-procurement system 120 using a set of graphical user interface tools.

(Viswanath; para. 0051).

Viswanath does not disclose, teach, or suggest using the graphical user interface tool for any other purpose. More importantly, Viswanath never discloses, teaches, or suggests using the graphical user interface tool to create a file that includes both a first set of tags defined by a document type definition that are used to select data for inclusion in a document, particularly a purchase order as alleged in the rejection of the claims, and a second set of tags defined by the document type definition that are used to specify *both a page style for the document and how to display the selected data within the document*.

That Viswanath fails to disclose, teach, or suggest this expressly claimed element is further evidenced in the Advisory Action wherein it has now been asserted in support of the rejection that “any business transaction system uses a graphical user interface to perform business functions.” While this statement may or may not be true, it is respectfully noted that this naked assertion still fails to evidence that Viswanath, or any other reference of record, discloses, teaches, or suggests the desirability of using a graphical user interface tool for the express purpose claimed as is required of a *prima facie* case of obviousness.

Rather than disclose, teach, or suggest these claimed elements, Viswanath discloses a system which generates OBI XML formatted purchase orders for sending to suppliers which includes a XML translation of an entire in-bound XML formatted requisition request received from a buyer which translation is performed using a “two-step XML file translation process.” Specifically, in Viswanath it is not a file created using a graphical user interface tool that defines *both* the style and the data that is to be selected for inclusion in the to-be-created purchase order. Instead, Viswanath discloses, in direct contrast to that which is claimed, that it is *the requisition request received at a “translation engine” that is used to select the data that is to be included in the to-be-created purchase order*. (Paras. 0014, 0018, 0019, 0023,

0024, 0054-0056, 0073, and 0084 for example). Thus, it is evident that nothing from Viswanath discloses, teaches, or suggests the claimed graphical user interface tool which allows for the creation of a file where the file created using the graphical user interface tool includes *all* of the elements set forth within the claims.

While the requisition request received at the “translation engine” of the Viswanath system performs the function of selecting the data that is to be included in the to-be-created purchase order, it is further evidenced within Viswanath that the received requisition request, which alone functions to select the data for inclusion in the to-be-created purchase order, is not the same file that also functions to specify the layout for the to-be-created purchase order. In this regard, Viswanath expressly describes that any formatting associated with the received requisition request is itself completely disregarded when the purchase order is created by the e-procurement system of Viswanath:

Contents of the purchase requisition are then mapped into an internal proprietary XML data format to allow for the quick and effective processing of the purchase requests. The mapped XML data is then **reformatted** and delivered in an XML format suitable for delivery in response to the purchase request. In one embodiment of the present invention, an Extensible Markup Language (XML) may be used to format content requests from the user to the purchasing and procurement system. The purchasing and procurement system then may use a sub-processing XDOC framework to generate XML data **fetch**ed and **parsed in response to the user's request**.

(Viswanath; para. 0018; emphasis added).

Rather than disclose, teach, or suggest using a file having a document definition including tags for performing the specific tasks claimed, Viswanath suggests using a translation process where the data selected, i.e., fetched, from an external XML catalog source as a function of the information within the requisition request is merely “formatted to transform the XML content from an external source into an appropriate markup content for delivery...” (Para. 0014). Thus, from the foregoing, it is evident that no single file disclosed within Viswanath,

whether created using a graphical user interface tool or otherwise, includes a document definition having tags which function to **both** select data for inclusion in a document and to specify *a page style for the document and how to display the selected data within the document*.

Considering now Matsakis, it is respectfully submitted that Matsakis similarly fails to disclose, teach, or suggest at least the claim elements discussed above that are missing from Viswanath. In this regard, Matsakis, like Viswanath, discloses nothing more than a system that functions to perform conversions between different XML formats to achieve server-to-server transfer of invoices, purchase orders and other business data streamed in the e-business context. Thus, while Matsakis generally mentions using XML in connection with invoices, in Matsakis, as in Viswanath, there is no disclosure, teaching, or suggestion of a file created using a graphical user interface tool that has a document definition which includes tags, let alone IML tags, that defines *both* the style and the data to select for inclusion in a document, let alone an invoice. Accordingly, it is respectfully submitted that nothing from Matsakis can be said to suggest modifying Viswanath to arrive at the exact invention claimed.

Finally, while Peat may disclose that one might define their own markup language with XML, like both Viswanath and Matsakis, nothing from Peat discloses, teaches, or suggest the claimed graphical user interface tool which allows for the creation of an IML file used to generate a formatted invoice that includes *all* of the elements set forth within the claims. Accordingly, it is respectfully submitted that nothing from Peat can be said to suggest modifying either Viswanath or Matsakis to arrive at the exact invention claimed.

In sum, it is respectfully submitted that the combination of Viswanath, Matsakis, and Peat cannot be said to disclose the entirety of the invention now claimed as is required of a *prima facie* case of obviousness. For at least this reason it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

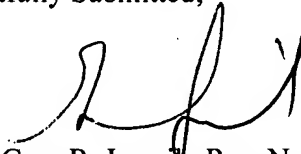
CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the reviewing panel is respectfully requested.

Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;



Date: August 21, 2006

By: Gary R. Jarosik, Reg. No. 35,906
Greenberg Traurig, LLP
77 West Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8449